

Remarks

The Office Action mailed December 13, 2007 has been carefully reviewed and the foregoing amendment has been made in consequence thereof. Claims 1-24 and 26-27 are now pending in this application, of which claims 1, 2, 5, 9, 16 and 21 are amended. Claims 25 and 28-39 are cancelled. It is respectfully submitted that the present claims define allowable subject matter.

Method claims 28-39 are cancelled without prejudice or disclaimer in response to the Office's position that these claims are directed to a non-elected invention. The cancellation of these claims is not made in acquiescence with the election requirement, but rather is made solely as a matter of expediency toward obtaining allowance of the present application. Applicants reserve the right to pursue the method claims in a divisional application.

The recitations of former dependent claim 25, now cancelled, which was indicated to recite allowable subject matter now appear in independent claim 21. Thus, independent claim 21 and its dependent claims 22-24 and 26-27 are believed to be allowable.

Applicants wish to preliminarily respond to the assertions in paragraph 16 of the Office Action that claims must be distinguished from prior art in terms of structure rather than function and that apparatus claims cover what a device is and not what it does. The remarks in the Office Action also insist that the Applicants point out structural differences and distinctions over the cited art, while effectively ignoring functional aspects of the subject matter claimed. These positions taken by the Office are directly contrary to MPEP § 2173.05 and controlling law on the issue, some of which is cited in MPEP § 2173.05. Applicants provide a courtesy copy of MPEP § 2173.05 herewith for the Examiner's reference, and specifically point out that MPEP § 2173.05 expressly authorizes Applicants to define their invention in functional terms, and also instructs Examiners to consider functional language just like any other limitations of a claim. Fairness dictates that the Office follow its own policies on such issues and Applicants respectfully request that the Examiner conduct examination consistent with the required procedures of the MPEP on such issues.

Applicants will now turn to art cited in the Office Action and the patentability of the remaining claims.

A. Bradshaw et al.

The rejection of claims 1-4, 9-11, 21, 22, 23, 26 and 27 under 35 U.S.C. § 102(b) as being anticipated by Bradshaw et al. in paragraph 6 of the Office Action is respectfully traversed.

Claims 21, 22, 23, 26 and 27 are submitted to be allowable in light of the amendment of claim 21 to include the allowable subject matter of former dependent claim 25, now cancelled.

Independent claim 1 has been amended for clarity and now recites a golf bag carrier comprising a body comprising a first end, a second end and a longitudinal axis extending therebetween, the body defining a cavity between the first and second end that is dimensioned to contain a golf bag with a set of golf clubs therein, each of the golf clubs in the set having a head, and each head having a top edge spaced farthest from a receiving end of the golf bag when the set of clubs are placed in the golf bag. An adjustable and flexible helmet is attached to said body within said cavity and proximate the first end of the body, said helmet configured to overlie and cover the heads of said golf clubs from above the top edges of the heads when the golf bag and clubs are placed in said cavity, the helmet maintaining the set of golf clubs in spaced relation from the first end of the body and preventing at least some of said golf clubs from moving within the cavity in a direction along said longitudinal axis toward the first end of the body.

Bradshaw et al. does not anticipate claim 1. Neither of the Bradshaw et al. protective members 48 and 50 overlie and cover the heads of said golf clubs from above the top edges of the heads as claim 1 now recites. Neither would the protective members 48 and 50 of Bradshaw et al. maintain the set of golf clubs in spaced relation from an end of the case and prevent at least some of said golf clubs from moving within the case in a direction along said longitudinal axis toward the first end of the body as claimed. The top end 14 of the case 10 of Bradshaw et al. would be the only positive constraint preventing movement of the clubs in a longitudinal direction toward the top end 14. Bradshaw et al. neither discloses nor suggests any desirability of the features presently claimed.

Claim 1 is submitted to be patentable over Bradshaw et al. The features of dependent claims 2-8, when considered in combination with the recitations of claim 1 are likewise submitted to be patentable over Bradshaw et al.

Independent claim 9 recites a golf bag carrier comprising a body comprising a longitudinal axis and defining a cavity adapted to contain a golf bag with a set of golf clubs therein, said body comprising at least one sleeve within said cavity; and a protective member passing through said sleeve, the protective member having a first free end and a second free end extending from opposing sides of the sleeve, said first free end configured to extend circumferentially around the golf bag in a first direction and said second free end configured to extend circumferentially around the golf bag in a second direction, whereby the entire circumference of the golf bag is protected by the protective member. The protective members 48 and 50 of Bradshaw et al. do not extend around the entire circumference of the golf bag and do not pass through a sleeve. Bradshaw et al. does not anticipate claim 9, and consequently cannot anticipate dependent claims 10 and 11. Bradshaw et al. likewise does not reasonably suggest the subject matter of claims 9, 10 and 11.

Applicants accordingly request that the § 102(b) rejection of claims 1-4, 9-11, 21, 22, 23, 26 and 27 over Bradshaw et al. be withdrawn.

B. Newman-Butler

The rejection of claims 1-3 and 16-24 under 35 U.S.C. § 102(b) as being anticipated by Newman-Butler in paragraph 13 of the Office Action is respectfully traversed.

Claims 21-24 are submitted to be allowable in light of the amendment of claim 21 to include the allowable subject matter of former dependent claim 25, now cancelled.

Newman-Butler discloses a golf bag 10. As such, Newman-Butler discloses a golf bag and not a carrier and this is distinguishable from the presently claimed invention on this basis alone, as claim 1 clearly recites “the body defining a cavity between the first and second end that is dimensioned to contain a golf bag with a set of golf clubs therein.” Thus, Newman-Butler, disclosing a golf bag, is incapable of meeting this recitation and cannot be an anticipating

reference. Simply put, Newman-Butler does not disclose a carrier at all, and neither anticipates nor reasonably suggests the subject matter recited in claim 1.

Newman-Butler discloses a hood 45 that is secured to a mouth of the golf bag 10 that can be raised into a protecting position shown in Figure 3, but the hood cannot qualify as the helmet recited in claim 1. The Newman-Butler hood 45 is not “within” the cavity defined in claim 1, nor is it proximate the first end of the body that defines the cavity as recited in claim 1. Also, the Newman-Butler hood 45 is not “configured to overlie and cover the heads of said golf clubs from above the top edges of the heads when the golf bag and clubs are placed in said cavity” and does not maintain the set of golf clubs “in spaced relation from the first end of the body and preventing at least some of said golf clubs from moving within the cavity in a direction along said longitudinal axis toward the first end of the body.” Newman-Butler neither anticipates nor reasonably suggests the helmet recited in claim 1.

Additionally, claim 2 further clarifies that the helmet comprises a head portion and a shaft portion, said head portion overlying and covering the top edges of the heads of the golf clubs from above in a direction substantially transverse to the longitudinal axis, and said shaft portion extending over a side of at least some of the golf club heads in a direction substantially parallel to said longitudinal axis. Newman-Butler does not disclose this. Because of the triangular shape of the Newman-Butler bag 10, the hood has the shape of a pyramid when extended, and as illustrated in the Figures no portion of the Newman-Butler Hood extends substantially parallel to the longitudinal axis of the bag. Rather, the sides of the Bradshaw et al. hood are necessarily oblique to the longitudinal axis of the bag.

The recitations of dependent claim 3, when considered in combination with the recitations of claims 1 or 2, likewise is not anticipated by Newman-Butler.

Independent claim 16 has been amended for clarity to recite a golf bag carrier comprising a body comprising a longitudinal axis and defining a cavity-dimensioned to receive and contain a golf bag with a set of golf clubs therein. Newman-Butler clearly does not meet this recitation. Claim 16 further recites “a golf club protection assembly adapted to protect the golf club shafts and the golf club heads within the cavity, said protection assembly comprising an adjustable and flexible helmet configured to overlie a top edge of the golf club heads from above the golf club

heads and constraining at least some of said golf clubs from moving relative to the body in a direction along said longitudinal axis, and a protective member separate from the helmet, the protective member configured to extend circumferentially around an outer periphery of the golf bag to surround the sides of the golf clubs, the protective member also extending over and protecting a portion of the helmet. Newman-Butler clearly does not disclose these features either. The hood 45 of Newman-Butler is not "within" the cavity defined in claim 16 and cannot constrain the golf clubs from moving relative to the body defined in claim 16. No element disclosed by Newman-Butler is fairly characterized as being separately provided from the hood and extending over and protecting a portion of the hood. Claim 16 is accordingly submitted to be patentable over Newman-Butler.

Dependent claims 17-20, when considered in combination with the recitations of independent claim 16, is likewise submitted to be patentable over Newman-Butler.

Applicants accordingly request that the § 102(b) rejection of claims 1-3 and 16-24 over Newman-Butler in paragraph 13 of the Office Action be withdrawn.

C. Bradshaw et al. in view of Newman-Butler and Moore et al.

The rejection of claims 1-24 and 26-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradshaw et al. in view of Newman-Butler and further in view of Moore et al. in paragraph 7 of the Office Action is respectfully traversed.

Claims 21-24 and 26-27 are submitted to be allowable in light of the amendment of claim 21 to include the allowable subject matter of former dependent claim 25, now cancelled.

Independent claims 1, 9 and 16 are submitted to be patentable over Bradshaw et al. or Newman-Butler individually for the reasons set forth above.

With respect to the combination of Bradshaw et al. and Newman-Butler, it is not believed that a prima facie case of obviousness of the presently claimed subject matter is presented by the references. The hood 45 of Newman-Butler facilitates a similar function to the protective members 48 and 50 of Bradshaw et al., namely to separate irons from woods, and appears to obviate any need for the type of case that Bradshaw et al. describes. Additionally, the triangular

shape of the Newman-Butler bag does not appear to be compatible with the Bradshaw et al. case or with the protective members 48 and 50 disclosed by Bradshaw et al. In view of at least these differences and incompatibilities, the carrier of claim 1 is not believed to be reasonably suggested by the combination of Bradshaw et al. and Newman-Butler.

Moore et al. does not resolve the deficiencies of Bradshaw et al. and Newman-Butler with respect to the subject matter claimed, nor does it add any pertinent teaching with respect to the subject matter claimed. Moore et al. disclose a golf club carrier having a body constructed of flexible strips of material 1 and 2 that may be placed flat on the ground or rolled to provide a tubular structure. The strip 2 is sewn to the body strip 1 and defines a plurality of pockets 3 for receiving golf clubs, and the pockets 3 may be positioned internally or externally of the tube when the body is rolled. One golf club may be received in each pocket 3, and a flap extension 4 may be folded down to cover the ends of the pockets 3. The flap 4 of Moore et al. is cited as corresponding to the helmet being claimed, but Applicants submit that the disclosure of Moore et al. is distinguishable from Bradshaw et al., Newman-Butler and the presently claimed invention on a number of levels.

For example, providing a folding flap 4 on a flat body as disclosed by Moore et al. is not immediately applicable to a three dimensional golf bag body that is not flat, such as the golf bags that the Bradshaw et al. case was designed to carry. The Moore et al. carrier does not involve protecting a set of clubs placed into a cavity at all, and neither does Newman-Butler.

To the extent that it would be attempted to implement a folding flap in a golf bag body that is not flat, Newman-Butler reflects the type of result that might be obtained, as the Newman-Butler hood appears to include a flap folding over the top of the hood 45 as depicted in Figure 3. This still would not result in the invention claimed, however, because either Newman-Butler or Moore et al. would apparently render another carrier, such as the type now being claimed, unnecessary. That is, the disclosures of Newman-Butler and Moore et al. both teach club protection features in stand-alone structures that appear to obviate any advantage of providing a separate carrier structure, nor do they reasonably suggest providing similar features in a carrier structure such as that claimed. The structures of Newman-Butler and Moore et al. could each be

placed in another carrier if desired, without any need to provide redundant club protection features in the carrier, such as those proposed by Bradshaw et al.

Still further, even assuming that one would have desired to forsake the integrated club protection features of the devices disclosed by Newman-Butler and Moore et al. and instead provide club protection features in another, separate carrier structure, Bradshaw et al. teaches a structure that would serve this purpose, without using any of the features described by either Newman-Butler or Moore et al.

For all the reasons set forth above, the presently claimed inventions of claims 1, 9, 16 and their dependent claims are not believed to be obvious. It is not believed that one of ordinary skill in the art, having common sense, would have been motivated to forsake the teachings of Newman-Butler and Moore et al. and their advantages of club protection without a separately provided carrier element, and then, instead of simply adopting the Bradshaw et al. club protection features in a separately provided carrier, rejecting the Bradshaw et al. club protection features in favor of a new carrier design using new and different elements to somehow arrive at the presently claimed invention. This appears to defy a common sense application of the teachings in the art. Alternatively stated, there is no objective evidence on the record that establishes why it would have been obvious to fail to use known club protection features taught by Bradshaw, Newman-Butler and Moore et al. and instead create new club protection features that differ from all of them that are now being claimed. One having common sense would apparently simply follow the teaching of the art where it applies, and not unnecessarily deviate from them without good reason to do so. The Office Action fails to supply any reason that can be supported with objective evidence on the record that one would have made the modifications proposed in the Office Action.

Independent claims 1, 9 and 16 are respectfully submitted to be patentable over Bradshaw et al. in view of Newman-Butler and further in view of Moore et al. Dependent claims 2-8, 10-15, and 17-20, when considered in combination with the recitations of independent claims 1, 9 and 16, are likewise submitted to be patentable over Bradshaw et al. in view of Newman-Butler and further in view of Moore et al.

Additionally, dependent claims 4 and 5 further recite that the body further comprises at least one sleeve within said cavity, and a protective member received in said sleeve, the protective member having a first free end and a second free end, said first free end configured to extend circumferentially around the receiving end of said golf bag in a first direction and said second free end configured to extend circumferentially around the receiving end of said golf bag in a second direction, wherein the protective member wraps around a side of at least some of the golf clubs and around a portion of the helmet. These features are not believed to be reasonably suggested by the cited art.

Applicants accordingly request that the § 103(a) rejection of claims 1-24 and 26-27 over Bradshaw et al. in view of Newman-Butler and further in view of Moore et al. in paragraph 7 of the Office Action be withdrawn.

D. Tan in view of Newman-Butler

The rejection of claims 1-4, 16, 18-20, 21-24 and 26-27 under 35 U.S.C. § 103(a) as being unpatentable over Tan (U.S. Patent No. 6,401,890) in view of Newman-Butler in paragraph 14 of the Office Action is respectfully traversed.

Claims 21-24 and 26-27 are submitted to be allowable in light of the amendment of claim 21 to include the allowable subject matter of former dependent claim 25, now cancelled.

Independent claims 1 and 16 are submitted to be patentable over Newman-Butler individually for the reasons set forth above. Tan does not cure the deficiencies of Newman-Butler with respect to the subject matter of claims 1 and 16. Tan does not disclose club protection features at all, and from this perspective adds nothing to teaching of Newman-Butler with respect to the claimed subject matter. As noted above, the Newman-Butler golf bag with the integrated hood appears to obviate any need for a separate carrier to transport the bag, nor does it suggest providing club protection features into a carrier. The Newman-Butler bag could presumably be placed in the Tan carrier without modification and still provide some protection for the clubs. It is not believed that one of ordinary skill in the art, having common sense, would have made the combination proposed in the Office Action. No objective evidence on the record supports the conclusion of obviousness set forth in the Office Action.

Independent claims 1 and 16 are therefore submitted to be patentable over Tan in view of Newman-Butler. Dependent claims 2-4 and 18-20, when considered in combination with independent claims 1 and 16, are likewise submitted to be patentable over Tan in view of Newman-Butler.

Applicants accordingly request that the § 103(a) rejection of claims 1-4, 16, 18-20, 21-24 and 26-27 over Bradshaw et al. in view of Newman-Butler and further in view of Moore et al. in paragraph 14 of the Office Action be withdrawn.

E. Lickton in view of Orestano or Hammill.

Claims 1-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Lickton (U.S. Patent No. 6,039,243) in paragraph 9 of the Office Action. Claims 6, 10 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lickton in view of Orestano (U.S. Patent No. 4,989,585) or Hammill (U.S. Patent No. 6,874,628) in paragraph 10 of the Office Action.

Elements 38 and 50 of Lickton are cited as the helmet and protective member recited in the claims. These elements do not, however, meet the recitations of independent claims, 1, 9 and 16 or the associated dependent claims. Element 38 is described by Lickton as a sack. Unlike the helmet recited in claim 1, the sack is not attached to the base 14 of the container 10 within the cavity of the base. Also unlike the helmet recited in claim 1, the helmet does not maintain a set of golf clubs in spaced relation from the first end of the base and prevent at least some of said golf clubs from moving within the cavity in a direction along said longitudinal axis toward the first end of the base. The wedge shape of the base would limit movement of the clubs therein and render such features unnecessary.

The strap 42 of Lickton does not pass through a sleeve in the base, does not have a first free end and a second free end extending from opposing sides of a sleeve, and does not protect the golf bag heads like the helmet of independent claim 9 does. Rather, the strap 42 is provided, as shown in Figure 2, at the lower end of the bag away from the golf club heads, and is referred to simply as a retention strap by Lickton et al.

Independent claim 16 recites that the protective member is configured to extend circumferentially around an outer periphery of the golf bag to surround the sides of the golf clubs, and the protective member also extending over and protecting a portion of the helmet. The Lickton retraining strap 42, because it is so far removed from the golf club heads, is incapable of doing this and cannot anticipate claim 16.

Orestano and Hammill do not cure the deficiencies of Lickton with respect to independent claims 1, 9 and 16. Each of Orestano and Hammill disclose devices unrelated to golf clubs and are believed to be inapposite to the invention being claimed.

Claims 1, 9, and 16 are therefore submitted to be patentable over Lickton individually or Lickton in view of Orestano or Hammill. When the recitations of dependent claims 2-8, 10-15 and 17-20 are considered in combination with the recitations of independent claims 1, 9 and 16, dependent claims 2-8, 10-15 and 17-20 are likewise submitted to be patentable.

Applicants accordingly request that the rejections relying upon Lickton be withdrawn.

F. Rea

The rejection of Claims 9-13 under 35 U.S.C. § 102(b) as being anticipated by Rea (U.S. Patent No. 3,245,448) in paragraph 8 of the Office Action is respectfully traversed.

Element 26 of Rea is cited as corresponding to the protective member recited, but it does not pass through a sleeve, does not have a first free end and a second free end extending from opposing sides of a sleeve, and would not protect an entire circumference of a golf bag and golf club heads as recited in independent claim 9. Applicants also submit that Rea relates to a bag for storing and carrying skis and would not anticipate claim 9 under any reasonable reading of the claim even if the partition means 26 disclosed by Rea were otherwise identical to the protective member claimed, which they are not.

Claim 9 is submitted to be patentable over Rea, and when dependent claims 10-13 are considered in combination with the recitations of claim 9, claims 10-13 are likewise submitted to be patentable over Rea.

Applicants respectfully request that the § 102(b) rejection of claims 9-13 under as being anticipated by Rea in paragraph 8 of the Office Action be withdrawn.

G. Parks

The rejection of Claims 9-15 under 35 U.S.C. § 102(b) as being anticipated by Parks et al. (U.S. Patent No. 6,446,851) in paragraph 11 of the Office Action is respectfully traversed.

Element 37 of Parks is cited as corresponding to the protective member recited, but it does not pass through a sleeve, does not have a first free end and a second free end extending from opposing sides of a sleeve, and would not protect an entire circumference of a golf bag and golf club heads as recited in independent claim 9. Parks discloses that that the element 37 is a strap forming a pouch 38 specifically dimensioned to house a paint-ball gun 40, and for that reason would not anticipate claim 9 under any reasonable reading of the claim.

Claim 9 is submitted to be patentable over Parks, and when dependent claims 10-15 are considered in combination with the recitations of claim 9, claims 10-15 are likewise submitted to be patentable over Parks.

Applicants respectfully request that the § 102(b) rejection of claims 9-15 under as being anticipated by Parks in paragraph 11 of the Office Action be withdrawn.

H. Johnson

The rejection of Claims 9-13 and 15 under 35 U.S.C. § 102(b) as being anticipated by Johnson (U.S. Patent No. 4,951,818) or alternatively under 35 U.S.C. § 102(b) in view of either Orestano or Hammill, as set forth in paragraph 12 of the Office Action, is respectfully traversed.

Elements 35 and 36 of Johnson et al. are cited as corresponding to the recited protective member, but they are not. Johnson discloses the straps 35 and 36 as fixed at the interior of the carrier. *See* col. 7, lines 5-7. Johnson does not disclose that the straps 35 and 36 pass through a sleeve, have a first free end and a second free end extending from opposing sides of a sleeve, or that they protect an entire circumference of a golf bag and golf club heads as does the protective member recited in independent claim 9. As clearly seen in Figure 3, the straps could not protect

the clubs even if they were passed through a sleeve because of their location in the carrier at a distance from the golf club heads.

Claim 9 is submitted to be patentable over Johnson et al., and when dependent claims 10-13 and 15 are considered in combination with the recitations of claim 9, 10-13 and 15 are likewise submitted to be patentable over Johnson et al.

Each of Orestano and Hammill disclose devices unrelated to golf clubs, golf bags or carriers and are believed to be inapposite to the invention being claimed, and do not cure the deficiencies of Johnson et al. with respect to the subject matter claimed.

Applicants respectfully request that the rejection of claims 9-13 and 15 that rely upon Johnson et al. in paragraph 12 of the Office Action be withdrawn.

I. Conclusion

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

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preamble does not render the claim indefinite under 35 U.S.C. 112, second paragraph. See *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished) (The preamble of the *Larsen* claim recited only a hanger and a loop but the body of the claim positively recited a linear member. The examiner rejected the claim under 35 U.S.C. 112, second paragraph, because the omission from the claim's preamble of a critical element (i.e., a linear member) renders that claim indefinite. The court reversed the examiner's rejection and stated that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor's contribution to the art. Upon review of the claim in its entirety, the court concluded that the claim at issue apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, paragraph 2.).

2173.05(f) Reference to Limitations in Another Claim

A claim which makes reference to a preceding claim to define a limitation is an acceptable claim construction which should not necessarily be rejected as improper or confusing under 35 U.S.C. 112, second paragraph. For example, claims which read: "The product produced by the method of claim 1." or "A method of producing ethanol comprising contacting amylose with the culture of claim 1 under the following conditions" are not indefinite under 35 U.S.C. 112, second paragraph, merely because of the reference to another claim. See also *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992) where reference to "the nozzle of claim 7" in a method claim was held to comply with 35 U.S.C. 112, second paragraph. However, where the format of making reference to limitations recited in another claim results in confusion, then a rejection would be proper under 35 U.S.C. 112, second paragraph.

2173.05(g) Functional Limitations [R-3]

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself,

render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. >In *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004), the court noted that the claim term "operatively connected" is "a general descriptive claim term frequently used in patent drafting to reflect a functional relationship between claimed components," that is, the term "means the claimed components must be connected in a way to perform a designated function." "In the absence of modifiers, general descriptive terms are typically construed as having their full meaning." *Id.* at 1118, 72 USPQ2d at 1006. In the patent claim at issue, "subject to any clear and unmistakable disavowal of claim scope, the term 'operatively connected' takes the full breath of its ordinary meaning, i.e., 'said tube [is] operatively connected to said cap' when the tube and cap are arranged in a manner capable of performing the function of filtering." *Id.* at 1120, 72 USPQ2d at 1008.<

Whether or not the functional limitation complies with 35 U.S.C. 112, second paragraph, is a different issue from whether the limitation is properly supported under 35 U.S.C. 112, first paragraph, or is distinguished over the prior art. A few examples are set forth below to illustrate situations where the issue of whether a functional limitation complies with 35 U.S.C. 112, second paragraph, was considered.

It was held that the limitation used to define a radical on a chemical compound as "incapable of forming a dye with said oxidizing developing agent" although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971).

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes

of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

2173.05(h) Alternative Limitations

I. MARKUSH GROUPS

Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925).

Ex parte Markush sanctions claiming a genus expressed as a group consisting of certain specified materials. Inventions in metallurgy, refractories, ceramics, pharmacy, pharmacology and biology are most frequently claimed under the Markush formula but purely mechanical features or process steps may also be claimed by using the Markush style of claiming. See *Ex parte Head*, 214 USPQ 551 (Bd. App. 1981); *In re Gaubert*, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975); and *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980). It is improper to use the term "comprising" instead of "consisting of." *Ex parte Dotter*, 12 USPQ 382 (Bd. App. 1931).

The use of Markush claims of diminishing scope should not, in itself, be considered a sufficient basis for objection to or rejection of claims. However, if such a practice renders the claims indefinite or if it results in undue multiplicity, an appropriate rejection should be made.

Similarly, the double inclusion of an element by members of a Markush group is not, in itself, sufficient basis for objection to or rejection of claims. Rather, the facts in each case must be evaluated to determine whether or not the multiple inclusion of one or more elements in a claim renders that claim indefinite. The mere fact that a compound may be embraced by more than one member of a Markush group recited in the claim does not necessarily render the scope of the claim unclear. For example, the Markush group, "selected from the group consisting of amino, halogen, nitro, chloro and alkyl" should be acceptable even though "halogen" is generic to "chloro."

The materials set forth in the Markush group ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property. While in the past the test for Markush-type claims was applied as liberally as possible, present practice which holds that claims reciting Markush groups are not generic claims (MPEP § 803) may subject the groups to a more stringent test for propriety of the recited members. Where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression.

When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation, then "wherein R is A, B, C or D" shall also be considered proper.

Subgenus Claim

Genus, subgenus, and Markush-type claims, if properly supported by the disclosure, are all acceptable ways for applicants to claim their inventions. They provide different ways to present claims of different scope. Examiners should therefore not reject Markush-type claims merely because there are genus claims that encompass the Markush-type claims.

See also MPEP § 608.01(p) and § 715.03.

See MPEP § 803.02 for restriction practice re Markush-type claims.

II. "OR" TERMINOLOGY

Alternative expressions using "or" are acceptable, such as "wherein R is A, B, C, or D." The following phrases were each held to be acceptable and not in violation of 35 U.S.C. 112, second paragraph in *In re Gaubert*, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975): "made entirely or in part of"; "at least one